

REMARKS**Status of the Claims**

Claims 1, 3-5, and 7-11 were pending at the time of the action. With entry of this response, claims 1 and 8 have been amended; and claims 3, 4, and 7 have been canceled without prejudice or disclaimer. Thus claims 1, 5, and 8-11 are now pending and presented for reconsideration.

Rejection of Claims Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 5 as allegedly lacking enablement. This claim recites a particular strain of *Rhizogenes* which is useful in the present invention. According to the Examiner, this strain cannot be enabled unless Applicants show that the material is “1) reproducible, 2) known and readily available to the public, or 3) deposited in compliance with 37 CFR 1.801-1.809.” Office Action mailed November 29, 2001, page 6. Applicants note that this same claim was identically rejected by the Examiner in the Office Action mailed November 29, 2001; addressed by Applicants on May 29, 2002, in response to that Office Action; and the rejection was ultimately withdrawn in view Applicants remarks in the final Office Action dated December 3, 2002.

Applicants reiterate their previous argument in response to this rejection. The *Agrobacterium rhizogenes* strain listed in claim 5 is publicly known and readily available to those in the art as identified in the enclosed reference (Savka et al, *Phytopathology*, Vol. 80. No. 5, 1990, pp. 503). Because it is publicly known and readily available, there is no need for Applicants to deposit the strain under the terms of the Budapest Treaty. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Rejection of Claims Under 35 U.S.C. §112, Second Paragraph

The Examiner rejected claim 8 as allegedly being indefinite for reciting “media containing ¼ MS.” According to the Examiner, “it is unclear which portion of the media is ¼.” Applicants wish to clarify that the claims of record recite “media containing ¼ strength Murashige and Skoog media.” There is nothing indefinite about this claim language. One of skill in the art readily understands that “¼ strength” media refers to a diluted composition relative to the full strength media. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Rejections Under 35 U.S.C. §102

The Examiner rejected claims 1, 3, 4, and 8-11 under 35 U.S.C. §102 as allegedly being anticipated by Tulson et al (EP 0262972). Applicants respectfully traverse the rejection. For a reference to anticipate, every element of the claim must be identically shown in that reference. Tulson describes the transformation of cucumber. The presently amended claims, (which now incorporate the subject matter of claim 7 that was free of the prior art), are directed to soybean, potato, cotton, or tomato. Nothing in Tulson’s cucumber teachings disclose or suggest the use of these crops. Thus, Applicants respectfully request that the rejection be withdrawn.

The Examiner also rejected claims 1, 3, and 7 under 35 U.S.C. §102 as allegedly being anticipated by Rech et al (Plant Cell Reports 8:33-35, 1989). Claim 4 was not rejected by the Examiner. Thus, Applicants have incorporated the subject matter of claim 4 into claim 1. Claims 3 and 7 have also been incorporated into claim 1 (and thus canceled). Thus, the rejection has been overcome and should be withdrawn.


Priority Claim

The acknowledges Applicants' claim for priority under 35 USC §119 to provisional application no. 60/098,402. However, the Examiner contends that the provisional application lacks support under 35 U.S.C. §112 for claims 1, 3-5, and 7-11. Applicants respectfully disagree. Enablement and written description support is found in the provisional application. Moreover, the Examiner's blanket statement concerning the matter, without any supporting facts or arguments, is improper. If the Examiner feels that the original disclosure lacks sufficient written description and enablement support for the claims, then specific details of the Examiner's belief should be documented in the record so they may be properly addressed by Applicants. In the absence of further evidence from the Examiner, Applicants respectfully request that the objection to the priority claim be withdrawn.

Conclusion

In light of the foregoing, applicants submit that all claims are in condition for allowance, and an early indication to that effect is earnestly solicited. The examiner is invited to contact the undersigned with any questions or suggestions relating to the referenced patent application.

Respectfully submitted,



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